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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,900	07/03/2001	Kevin Taylor	H0075/7076/REH	3612

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EXAMINER

SORKIN, DAVID L

ART UNIT PAPER NUMBER

1723

DATE MAILED: 01/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/898,900

Applicant(s)

TAYLOR ET AL.

Examiner

David L. Sorkin

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 and 27-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 17-26 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

**DETAILED ACTION*****Election/Restrictions***

1. Applicant's election of Invention I, claims 1-13 and 17-26 in Paper No. 7 is acknowledged. New claim 35 is also considered to be direct to elected Invention I. It is considered that claim 35 is distinct from Invention II (and therefore not a "linking claim") for the following reason: The subject matter of claim 35 and Invention II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus could be used to mix other materials such as concrete, paint, food or any other types of material. Also, rather than feeding additive using "means for feeding" which are disclosed in the specification or equivalents, one could feed additives generally by hand using a shovel. Rather than transferring material using "means for transferring" which are disclosed in the specification or equivalents, one could feed additives generally by hand using a shovel. Furthermore, while the method claims require transferring/delivering to an "asphalt mixing box", the apparatus claims do not require any mixing box and the claimed apparatus could be used to transferred material to many of the places, such as a road surface, a building foundation, etc. The examiner acknowledges applicant's request to "see MPEP 809.03"; however, as explained in MPEP 809.03, linking claims are claims which are inseparable from more than one

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Invention, while claim 35 is distinct from the method invention as explained above, and therefore is not a linking claim.

### ***Drawings***

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "vertical auger" and "control system" must be shown or the features canceled from the claims. New matter must not be entered.
4. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Note: it is considered that no "asphalt mixing box" is a required element of any elected claim. Phrases which mention an "asphalt mixing box" have been treated as discussions of an intended use for the claimed apparatus.
7. Claims 1-6, 8-13 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Rudolph (US 4,498,783). Regarding claim 1; Rudolph ('783) discloses

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an apparatus comprising a receptacle (21); a scale (43), a mixer (26,27,28,29); and a transport system (41). Regarding claim 2, the apparatus comprises one more inlets (24, 25) that communicate with the receptacle. Regarding claim 3, the scale is adapted to measure gravimetric amounts of materials in the receptacle and comprises one or more load cells (43) tared to account for the weight of the receptacle (see col. 4, lines 22-29). Regarding claim 4, the mixer comprises a vertical auger (26,27,28,29) centrally located in said receptacle. Regarding claim 5, the transport system comprises a motor driven rotary valve (see col. 3, lines 55-59). While the apparatus of Rudolph ('783) would be capable of performing the operation described in claim 6, applicant is advised that "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claims" *Ex parte Thilbault*, 164 USPQ 666, 667 (Bd. App. 1969). Also, "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* 152 USPQ 235 (CCPA 1967). Regarding claim 8, Rudolph ('783) discloses an apparatus comprising a receptacle (21) having an inlet (23,24); weighing means (43) connected to the receptacle, mixing means (26,27,28,29); transfer means (41) and a programmable control system (44,45,46,47,48,49,50) having input from said weighing means and controlling outputs to said inlet of said receptacle and to said mixing means and said transferring means (see col. 3, lines 47-59; col. 4 lines 30 to col. 6 line 23; Fig. 1). Regarding claim 9, the apparatus has one or more inlets (23,24). Regarding claim 10, said weighing means comprises one or more load cells (43). Regarding claim 11, the mixing means comprises a vertical auger (26,27,28,29)

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centrally located in said vessel. Regarding claim 12, the transfer means comprises a motor driven rotary valve (see col. 3, lines 55-59). While the apparatus of Rudolph ('783) would be capable of performing the operation described in claim 13, applicant is advised that "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claims" *Ex parte Thilbault*, supra. Also, "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* supra. Regarding claim 35, Rudolph ('783) discloses an apparatus comprising a means for feeding (1-20); weighing means (43), mixing means (26,27,28,29); means for transferring (41).

8. Claim 1-13, 17-26 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Hood (US 5,908,240). Regarding claim 1; Hood ('240) discloses an apparatus comprising a receptacle (12); a scale (37), a mixer (13); and a transport system (15,16). Regarding claim 2, the apparatus comprises one more inlets (28, 30) that communicate with the receptacle. Regarding claim 3, the scale is adapted to measure gravimetric amounts of materials in the receptacle and comprises one or more load cells (37) tared to account for the weight of the receptacle (see col. 5, lines 10-13). Regarding claim 4, the mixer (13) comprises a vertical auger (18) centrally located in said receptacle. Regarding claim 5, the transport system comprises a motor driven rotary valve (15)). While the apparatus of Hood ('240) would be capable of performing the operation described in claim 6, applicant is advised that "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in

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determining the patentability of the apparatus claims" *Ex parte Thilbault*, supra. Also, "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* supra. Regarding claim 7, the apparatus further comprises a transfer pipe (40,41) connected to the receptacle.

Regarding claim 8, Hood ('240) discloses an apparatus comprising a receptacle (12) having an inlet (28,30); weighing means (37) connected to the receptacle, mixing means (13); transfer means (15,16) and a programmable control system (60) having input from said weighing means and controlling outputs to said inlet of said receptacle and to said mixing means and said transferring means (see Fig. 3; col. 4, lines 23-28; col. 5, lines 6-13). Regarding claim 9, the apparatus has one or more inlets (28,30).

Regarding claim 10, said weighing means comprises one or more load cells (37).

Regarding claim 11, the mixing means comprises a vertical auger (18) centrally located in said vessel. Regarding claim 12, the transfer means comprises a motor driven rotary valve (15). While the apparatus of Hood ('240) would be capable of performing the operation described in claim 13, applicant is advised that "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claims" *Ex parte Thilbault*, supra. Also, "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* supra. Regarding claim 17, Hood ('240) discloses an apparatus comprising a receptacle (12) having an inlet having an inlet (28, 30); a mixer (13); a transfer pipe (40,41) extending from an outlet (to 16) of the receptacle, and a pneumatic pressure source connected to said transfer pipe (see

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col. 3, lines 2-6; col. 4, line 61; col. 5, lines 32-40). Regarding claim 18, the transfer pipe has a vertical portion (see at/near 16 in Fig. 1). Regarding claim 19, the apparatus further comprises a valve (33; see also col. 8, lines 17-25). Regarding claim 20, means (32,33) for diverting pressure are disclosed. While the apparatus of Hood ('240) would be capable of performing the operation described in claims 21, 23 and 26, applicant is advised that "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claims" *Ex parte Thilbault*, supra. Also, "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* supra. Regarding claim 22, weighing means (37) connected to the receptacle and transfer means (16) are disclosed. Regarding claim 24, a programmable control system (60) having input from said weighing means and controlling outputs to said inlet of said receptacle and to said mixer and said transferring means (see Fig. 3; col. 4, lines 23-28; col. 5, lines 6-13). Regarding claim 25, means for diverting (32,33) are disclosed and the controller is programmable to operate said diverting means (see Fig. 3; col. 4, lines 23-28). Regarding claim 35, discloses an apparatus comprising a means for feeding (28,29,30,31); weighing means (37), mixing means (13); means for transferring (40,41).

### **Conclusion**

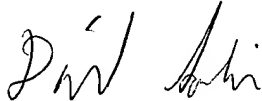
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

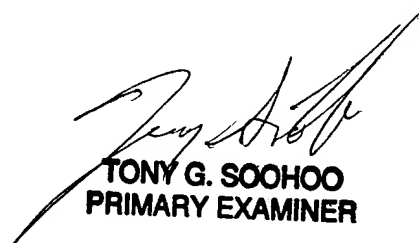
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



David Sorkin

January 10, 2003



**TONY G. SOOHOO**  
**PRIMARY EXAMINER**